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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,794	03/22/2001	Allen R. DeCotiis	PNX1P001	5815
24108	7590	05/06/2005	EXAMINER	
CARLTON FIELDS, PA P.O. BOX 3239 TAMPA, FL 33601-3239			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,794

Applicant(s)

DECOTIS ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-14-05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-18 have been examined.

Response to Arguments and Amendments

2. Applicant is of the opinion that Rothman et al. system is insufficient as prior art because Rothman et al. teach away from surveys and therefore cannot be combined with the data gathering method of Schulze Jr. To support their position, Applicant cites passages that Applicant believes renders the Rothman et al. teaching "unsatisfactory for its intended purpose" if the Rothman et al. teaching were implemented with surveys (Amendment and Response to Office Action, 2-28-05, page 15). However, the Examiner finds that Rothman et al. do not share Applicant's sentiments regarding their invention as Rothman et al. initiate their system by collecting customer data via surveys ('168, column/line 2/65-3/5). Rothman et al. disclose gathering customer data via an interactive process, such as through the use of telephone calls, direct mailing, e-mail contact, or other methods of contacting a customer. Rothman et al. also teach collecting customer information when a customer fills out an application for service, such as information about customer purchases, account activity, and interaction with the financial institution or entity gathering the information; and

that customer purchase information may be gathered in other manners, based on the products and services to be potentially offered to a customer ('168, column/line 3/65-4/17). Therefore, it would have been obvious to one of ordinary skill to use the standardized interactive data collecting method of Schulze Jr. (e.g. surveys) in order collect customer information regarding future purchases ('564, column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56). Further, Rothman et al. state,

Standardization of customer purchase information allows an entity, such as, for example, a financial institution or a credit card provider, to better meet the needs of the customer. The more information gathered about a customer, the easier to tailor offers of products and services to what a particular customer really wants or needs ('168, column 4, lines 17-22)

Therefore, one of ordinary skill would have instantly realized the benefit of standardized interactive data gathering methods such as surveys to the Rothman et al. system in order to gather information about the customer's intent to purchase ('564, column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56) and then develop models ('168, abstract; figure 6; column 4, lines 35-55; column 5, lines 48-64) based on said surveys in order to allow goods and services providers to more effectively and directly target consumers ('564, column 2, lines 23-30).

Regarding the appliance of "101", the added language (claims 1 and 13) does not overcome the rejection as the claim continues to produce an outcome

(i.e. a score or propensity) without a practical application, and was produced without transformation of the data by a machine, such as a computer. Hence the claimed invention does not produce useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)). The Applicant, for example, has amended the preamble of claim 1 to include the language of "at least partially implemented via a computer" however, this addition does not give life meaning and vitality to the claim and therefore does not limit the claim (*Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997)).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed, hence, the claimed invention does not promote the progress of science and the useful arts. Claim 1 is merely an abstract idea (e.g. a mathematical formula) as it is not tied to the

computer arts. Further, the "usefulness" of claims 1, 7 and 13 is not apparent. Specifically, the outcome of the Applicant's claimed processing is merely a number without a practical application (e.g. claims 1, 7 and 13), and was produced without transformation of the data by a machine, such as a computer (e.g. claims 1 and 13). Hence the claimed invention does not produce useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothman et al., U.S. Patent No. 6,505,168 in view of Schulze, Jr., U.S. Patent No. 6,233,564.

As per claims 1-18, Rothman et al. teach a method for ranking customers comprising:

- identifying a plurality of customers (figure 5; column 4, lines 7-17)
- retrieving first and second information on each of the customers (column/line 2/65-3/5; column 4, lines 7-17; column 7, lines 26-45) from customer personal data, customer purchase history, or from surveys (column/line 2/65-3/5; column/line 3/65-4/17)
- creating an equation, a model, with a plurality of characteristics and weight (i.e. equal) for each characteristic, and using the equation to calculate a score (that represents a propensity to purchase goods or services) for each customer based on the first and second information and the model (abstract; figure 6; column 4, lines 35-55; column 5, lines 48-64)
- first information such as credit card information (column/line 3/65-4/17; column 10, lines 48-55)
- sorting customers based on score (abstract; figure 6)

However, Rothman et al. do not specifically recite using surveys to collect information on an intent to purchase a particular product. Schulze Jr. teaches a method for collecting first and second information using surveys (abstract). Specifically, Schulze Jr. teaches asking customers about "anticipated major purchases" (column 2, lines 23-30; column 6, lines 46-53; column 8, lines 58-65; column 10, lines 47-52; column 15, lines 50-56). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rothman et al. and

Schulze Jr. in order to allow goods and services providers to more effectively and directly target consumers ('564, column 2, lines 23-30).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

May 3, 2005


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600